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A32964-072874.0132

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Achenbach
Serial No. : 09/463,851 Examiner: Patten, P.
Filed : June 5, 2000 Group Art Unit: 1651
For : PHARMACEUTICAL COMPOUNDS ISOLATED FROM ARISTOLOCHIA
TALISCANA

LETTER ESTABLISHING UNINTENTIONAL DELAY

I hereby certify that this paper is being deposited with the United States
Postal Service as first class mail in an envelope addressed to:
Office of Petitions

January 4, 2002
Date of Deposit

Rochelle K. Seide
Attorney Name

Rochelle K. Seide
Signature

32,300
Registration No.

January 4, 2002
Date of Signature

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JAN 16 2002

OFFICE OF PETITIONS

Assistant Commissioner for Patents
Washington, D.C. 20231

ATTENTION: OFFICE OF PETITIONS -- BOX DAC

Sir:

Applicant respectfully petitions to revive the above-captioned application in
accordance with the provisions of 37 U.S.C. §1.137(b) as the abandonment was unintentional.

This application was abandoned due to an inadvertent error regarding the filing of an improper

NY02:363992.1

CPA for the above-identified application. The relevant background is as follows.

The above-identified application was originally filed under 35 U.S.C. § 371 as the national stage of an international application on January 31, 2000. However, an oath or declaration was not provided by the Applicant. A Notification of Missing Requirements was mailed April 3, 2000. In response, Applicant's filed a Combined Declaration and Power of Attorney on June 5, 2000. A Notification of Acceptance of Application mailed June 15, 2000 and Filing Receipt mailed June 16, 2000 indicated June 5, 2000 to be the official filing date.

Subsequently, an Office Action was mailed January 4, 2001 for the the above-identified application. The Applicant filed a Continued Prosecution Application (CPA) under 37 C.F.R. §1.53(d) on July 3, 2001. Since the original filing date was January 31, 2000, Attorneys for the Applicant made an inadvertent error in believing that the CPA request was valid for the pending application. Since a request for CPA is not valid in an application filed on or after May 29, 2000, it was treated by the USPTO as a Request for Continued Examination (RCE). A Notice of Improper Request for Continued Examination (RCE) mailed August 6, 2001 indicated that the request was not accompanied by a submission and that the time period set forth in the final Office Action continued to run from the mailing date of that Office Action. A response to the Office Action mailed January 4, 2001 was set to expire three months from the mailing date on July 5, 2001.

Repeated attempts to call the USPTO were made to clarify the status of the application. On September 6, 2001, Examiner Patricia Patten, indicated that the application was abandoned. Upon such realization, the undersigned Attorney for the Applicant prepared and filed a Petition under 37 CFR §1.53(e) to convert Improper CPA Application filed under 37 CFR §1.53(d) to an Application under CFR §1.53(b) on September 17, 2001. A Notice of Abandonment was mailed September 6, 2001. Since the Petition was received by the USPTO OIPE on September 19, 2001, as evidenced by a postcard enclosed herewith, it was presumed that the petition was being examined. A call to the Office of Petitions on December 17, 2001 indicated that the Petition was being examined.

A call to the Office of Petitions on the morning of January 3, 2002 indicated that file was being reviewed by the Examiner. Examiner Patten confirmed that the application was abandoned, and that she was not reviewing the application. A call to a Petitions Attorney in the Office of Petitions indicated that there was no record of the Petition and he recommended the filing of the present Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b). In support of this petition, Applicants submit a proper Request for Continued Examination (RCE), Petition for Extension of Time and amendment in response to Office Action mailed January 4, 2001.

Applicants enclose herewith the following papers: (1) Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b) (2 pages); (2)

Request for Continued Examination (1 page); (3) Petition for Extension of Time (2 pages); (4) 13 pages of an Amendment and cited references; (5) 5 pages of the Petition under 37 CFR §1.53(e) to convert Improper CPA Application filed under 37 CFR §1.53(d) to an Application under CFR §1.53(b); (6) postcard indicating receipt of the Petition under 37 CFR §1.53(e) to convert Improper CPA Application filed under 37 CFR §1.53(d) to an Application under CFR §1.53(b); (7) 5 pages of the Continued Prosecution Application request papers mailed July 3, 2001 and a check for \$1470.00.

A check in the amount of \$485 accompanied the Continued Prosecution Application request papers mailed July 3, 2001 to cover the amount of the CPA filing fee of \$355 and Suspension of Action fee of \$130. In an overabundance of caution, enclosed is an additional payment for the Request for Continued Examination in the amount of \$370. The Commissioner is hereby authorized to refund payment of excess fees associated with this communication to Deposit Account No. 02-4377. A duplicate copy of this sheet is enclosed.

A32964-072874.0132

Favorable consideration of the present Petition is respectfully requested.

Respectfully submitted,

BAKER BOTTS, L.L.P.

By: Rochelle K. Seide

Rochelle K. Seide
Patent Office Reg. No. 32,300
Attorney for Applicants

30 Rockefeller Plaza
New York, NY 10112

(212)408-2500



#13
(copy)

A32964-072874.0132

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Achenbach
Serial No. : 09/463,851 Examiner: Patten, P.
Filed : June 5, 2000 Group Art Unit: 1651
For : PHARMACEUTICAL COMPOUNDS ISOLATED FROM ARISTOLOCHIA
TALISCANA

**PETITION UNDER 37 CFR §1.53(e) TO CONVERT IMPROPER CPA APPLICATION
FILED UNDER 37 CFR §1.53(d) TO AN APPLICATION UNDER CFR §1.53(b)**

I hereby certify that this paper is being deposited with the United States
Postal Service as first class mail in an envelope addressed to:
Office of Petitions

September 17, 2001

Date of Deposit

Rochelle K. Seide
Attorney Name

Rochelle K. Seide
Signature

32,300

Registration No.

September 17, 2001

Date of Signature

Office of Petitions
Four Crystal Plaza, suite 3C23
2201 South Clarke Place
Arlington, VA 22202

Attn: Petitions Examiner Christina Tartera

Madam:

Applicants respectfully petition herein under 37 C.F.R.. §1.53(e) to convert the

NY02:346551.1

Adjustment date: 05/14/2002 AKELLEY
09/21/2001 GTEFFERA 00000130 09463851
01 FC:122 -130.00 OP

Repln. Ref: 05/14/2002 AKELLEY 0013594600
DAH:024377 Name/Number:09463851
FC: 704 \$130.00 CR

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Repln. Ref: 05/14/2002 AKELLEY 0014002400
DAH:024377 Name/Number:09463851
FC: 704 \$1470.00 CR

CPA application filed under 37 C.F.R. §1.53(d) to a continuation application filed under 37 C.F.R. §1.53(b). The relevant background is as follows.

The above-identified application was originally filed under 35 U.S.C. § 371 as the national stage of an international application on January 31, 2000. However, an oath or declaration was not provided by the Applicant. A Notification of Missing Requirements was mailed April 3, 2000. In response, Applicant's filed a Combined Declaration and Power of Attorney on June 5, 2000. A Notification of Acceptance of Application mailed June 15, 2000 and Filing Receipt mailed June 16, 2000 indicated June 5, 2000 to be the official filing date.

Subsequently, an Office Action was mailed January 4, 2001 for the the above-identified application. The Applicant filed a Continued Prosecution Application (CPA) under 37 C.F.R. §1.53(d) on July 3, 2001. Since the original filing date was January 31, 2000, Attorneys for the Applicant made an inadvertent error in believing that the CPA request was valid for the pending application. Since a request for CPA is not valid in an application filed on or after May 29, 2000, it was treated by the USPTO as a Request for Continued Examination (RCE). A Notice of Improper Request for Continued Examination (RCE) mailed August 6, 2001 indicated that the request was not accompanied by a submission and that the time period set forth in the final Office Action continued to run from the mailing date of that Office Action. A response to the Office Action mailed January 4, 2001 was set to expire three months from the mailing date on July 5, 2001.

Repeated attempts to call the USPTO were made to clarify the status of the application. On September 6, 2001, Examiner Patricia Patten, indicated that the application was abandoned. Upon such realization, the undersigned Attorney for the Applicant prepared and filed this petition for the above-identified application. At no time did Applicant or Applicant's Attorney intend to abandon the application.

Applicants respectfully petition herein under 37 C.F.R. §1.53(e) to convert the CPA application filed under 37 C.F.R. §1.53(d) to a continuation application filed under 37 C.F.R. §1.53(b). The Federal Register vol 65, No.159 from August 16, 2000 states the following:

If an applicant files a request for a CPA of an application to which CPA practice no longer applies and does not want the request for a CPA to be treated as a request for continued examination under 1.114, the applicant may file a petition under §1.53(e) requesting that the improper CPA be converted to an application under §1.53(b). The requirements for such a petition under 1.53(e) are identical to those set forth in section 201.06(b) of the Manual of Patent Examining Procedure (7th ed.1998) (Rev. 1, Feb. 2000) (MPEP) for converting an improper file wrapper continuing (FWC) application under former 1.62 to an application under 1.53(b).

In support of this petition, Applicants enclose herewith the following papers: (1) a true copy of the complete application Serial No. 09/463,851 filed June 5, 2000 including 36 pages of specification, 11 pages of claims, and 8 sheets of informal drawings, 1 page of abstract, 3 pages of original transmittal letter, 4 pages of Form PCT/RO/101 (PCT Request), 7 pages of Form PCT/ISA/210 (International Search Report), 1 page of Form PCT/IB/332 (Information

Concerning Elected Offices Notified of Their Election), 1 page of Form PCT/IB/308
(Notification of International Application to Designated Offices), 1 page of Form PCT/IB/306
(Notification of the Recording of A Change); (2) 3 pages of a copy of the Combined Declaration
and Power of Attorney document from application Serial No. 09/371,293; (3) 6 pages of a
Preliminary Amendment mailed June 27, 2000; (4) 4 pages of an Information Disclosure
Statement and PTO 1449 mailed June 27, 2000; (5) 13 pages of a Preliminary Amendment and
cited references mailed August 13, 2001; (6) 2 pages of a copy of the Notice of Improper Request
for Continued Examination; (7) 5 pages of the continued prosecution application request papers
mailed July 3, 2001; and (8) a check for \$130.00 in payment of the required petition fee under 37
C.F.R. 1.17(i).

Please charge any additional fees or credit any overpayment to Deposit Account
No. 02-4377. A duplicate of this sheet is enclosed.

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Favorable consideration of the present Petition is respectfully requested.

Respectfully submitted,

BAKER BOTTS, L.L.P.

By: Rochelle K. Seide

Rochelle K. Seide
Patent Office Reg. No. 32,300
Attorney for Applicants

30 Rockefeller Plaza
New York, NY 10112

(212)408-2500



BAKER BOTTS LLP

DAE
#15

**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED
UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

Docket Number (Optional)
A32964 072874.0132

First named inventor: Achenbach

Application No.: 09/463,851

Art Unit: 1651

Filed: June 5, 2000

Examiner: Patten, P

Title: PHARMACEUTICAL COMPOUNDS ISOLATED FROM ARISTOLOCHIA TALISCANA

Attention: Office of Petitions
Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

NOTE: If information or assistance is needed in completing this form, please contact Petitions
Information at (703) 305-9282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the Office notice or action plus an extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee --required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
- (4) Statement that the entire delay was unintentional.

1. Petition fee

☒ Small entity-fee \$ 640 (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

☐ Other than small entity - fee \$ _____ (37 CFR 1.17(m))

2. Reply and/or fee

A. The reply and/or fee to the above-noted Office action in
the form of Request for Continued Examination and Amendment (identify type of reply):

- ☐ has been filed previously on _____
☒ is enclosed herewith.

B. The issue fee of \$ _____

- ☐ has been paid previously on _____
☐ is enclosed herewith.

[Page 1 of 2]

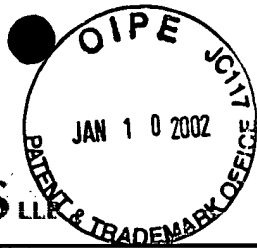
01/15/2002 CCHAU1 00000035 09463851

02 FC:241
Adjustment date: 05/14/2002 AKELLEY 640.00 OP
01/15/2002 CCHAU1 00000035 09463851
02 FC:241 -640.00 OP

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BAKER BOTTS LLP

3. Terminal disclaimer with disclaimer fee

- ☐ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.
- ☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$ _____ for a small entity or \$ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE. The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D))].

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

January 4, 2002

Date

Rochelle K. Seide

Signature

Telephone
Number: (212) 408-2626

Rochelle K. Seide

Typed or printed name

30 Rockefeller Plaza

Address

New York, NY 10112-4498

Enclosures: ☒ Fee Payment

☒ Reply

☐ Terminal Disclaimer Form

☒ Additional sheets containing statements establishing unintentional delay

☐ Other: _____

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CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

☒ deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Box DAC, Washington, D.C. 20231.

☐ transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (703) 308-6916.

January 4, 2002

Date

Rochelle K. Seide

Signature

Rochelle K. Seide

Type or printed name of person signing certificate